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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,283	10/28/2003	Robert Richard Dykstra	9086M	3960
27752 7590 02/08/2007 THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL BUSINESS CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224			EXAMINER MOSS, KERI A	
			ART UNIT 1743	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/08/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/695,283	<b>Applicant(s)</b> DYKSTRA ET AL.	
	<b>Examiner</b> Keri A. Moss	<b>Art Unit</b> 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 6, 10, 11, 13, 14 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's Amendment filed November 15, 2006 is hereby acknowledged.

Claims 1-16 are pending.

### ***Terminal Disclaimer***

1. The terminal disclaimer filed on November 15, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of patents granted on applications 10/695282, 10/698309, 10/698871 has been reviewed and is NOT accepted.

The application/patent being disclaimed has been improperly identified since the number used to identify the application or date being disclaimed is incorrect. The correct number is 10/695,282, which is missing from the terminal disclaimer. Also, one of the dates listed for 10/698,309 is incorrect because the correct filing date is 10/31/03.

### ***Response to Amendment***

2. Applicant's amendments have overcome the rejection under 35 USC 112, 2<sup>nd</sup> paragraph.
3. New rejections under 35 USC 112, 2<sup>nd</sup> paragraph and 35 USC 102 have been added in this office action.

***Claim Interpretation***

As stated by the examiner in a previous office action, claims 1-11 are product by process claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695,698, 227 USPQ 964, 966 (Fed. Cir. 1985).

"The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

Therefore, a reference that meets the structural limitations in the claims, specifically a benefit agent delivery system comprising a water-insoluble polymer particle and a benefit agent, demonstrates that the claims are unpatentable. Process steps such as "wherein the polymer particle and the benefit agent are separately added

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to a matrix to form the benefit agent delivery system" do not limit the structural language of the claim and are not given patentable weight.

### ***Claim Objections***

4. Claims 3, 4, 6, 10, 11, 13, 14 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 3, 4, 6, 10 and 11 do not further limit the structure of the delivery system but instead describe process steps or intended use. Claims 13, 14 and 16 are not positive steps further limiting the method of making a granular or liquid composition. These claims describe a properties of the composition when subjected to analysis, but applicant has not claimed a method of analysis. Applicant must positively recite the protocol steps in order to claim the properties demonstrated by the protocol steps.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claim 1, it is unclear what structural elements make up the benefit agent delivery system. It is unclear if applicant intends to define the delivery system as comprised of a matrix including a water-soluble polymer particle and a benefit agent. As presently drafted, the claim appears to incorporate the process by which the system is formed; however the matrix is not positively claimed as an element of the invention. Examiner also notes that applicant has not positively claimed a substrate.

Regarding claim 6, it is unclear whether applicant is attempting to further limit the perfume raw material of claim 5. The claim as presently drafted is directed not to the perfume raw material but to properties of the polymer particle regarding its relationship to two different perfume raw materials that are not positively claimed as elements of the invention.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims **1-16** are rejected under 35 U.S.C. 102(e) as being anticipated by Schindler et al (USP 6,436,421). Schindler discloses a benefit agent delivery system including a water-insoluble polymer particle and a benefit agent added to a liquid matrix (emulsion) that is diluted with water (column 3 lines 9-24). The substrate may be a pest, the locus of the pest or a food source of the pest (column 3 lines 25-27). The benefit agent may be a perfume raw material such as benzyl acetate (claim 1), which has a low Kovats index per applicant's specification.

9. Claims **1-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Claffey (USP 4,318,746). Claffey discloses a method for making a liquid composition containing a benefit agent delivery system comprising the steps of providing a liquid matrix (gel) adding a water-insoluble polymer particle to the matrix (column 4 lines 9-10) and adding a benefit agent such as benzyl alcohol, which has a low Kovats index, then applying the mixture to a substrate (column 4 lines 15-20).

10. Claims **1-16** are rejected under 35 U.S.C. 102(b) as being anticipated by Skodell (USP 5,556,450). Skodell teaches a method for making a liquid composition containing a benefit agent delivery system comprising the steps of providing a liquid matrix (example 1), adding a water-insoluble polymer particle (column 2 lines 21-30) and adding a benefit agent (benzyl alcohol) (Table 1).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keri A. Moss whose telephone number is 571-272-8267. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Keri A. Moss  
Examiner  
Art Unit 1743

KAM 2/5/07



BRIAN R. GORDON  
PRIMARY EXAMINER